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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,726	01/22/2001	Carolyn Pianin	21300.105005	1308
20786	7590	08/28/2007		
KING & SPALDING LLP 1180 PEACHTREE STREET ATLANTA, GA 30309-3521			EXAMINER VIG, NARESH	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 08/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/766,726	<b>Applicant(s)</b> PIANIN, CAROLYN	
	<b>Examiner</b> Naresh Vig	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 11-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is in reference to response received 31 May 2007. In the response received, applicant has filed a Declaration Of Prior Invention Under 37 C.F.R. 1.131 to antedate the cited reference Chatterjee et al US Patent 6,922,675. Applicant statement stating that Service Center Use Cases Document which was created 02 August 2000 [Exhibit A], as the document to support the statement that the conceiving of the claimed invention of the instant application prior to Chatterjee et al. invention is acknowledged. Claims 1-4 and 11-26 are pending for examination.

### ***Response to Arguments***

Applicant's arguments and concerns in reference to amended claims and newly added claims are responded to in response to the currently pending claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1 – 4 and 11 – 26** are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As currently claimed by the applicant as their claimed invention, it is not clear whether the matching of the service provider with the request criteria is performed using the service provider criteria stored in the computer system, or, service provider criteria is requested every time there is a service request criteria received by the computer implemented method.

In addition, applicant has not positively claimed how the services provider is identified when there are plurality of service providers who can fulfill the request criteria, and, how the claimed invention fulfills the request criteria when the request criteria has plurality of services for the same real estate property.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4 and 11-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Clark US Patent 6,351,738 in view of archived web pages of HomeGain.com hereinafter known as HomeGain.**

**Regarding claim 1, 12 and 20,** Clark teaches providing a computer implemented method with for procuring services in a commercial transaction. Clark teaches that participants 414, 414' may include building contractors and subcontractors, insurance or securities brokers, real estate brokers, accounting, architectural, engineering, scientific, transportation, distribution, manufacturing, retail vending, legal or medical consultants or specialists, and so on [Clark, Fig. 4 and disclosure associated with the Figure]. Clark teaches:

providing a virtual marketplace to market services of a plurality of providers of commercial real estate services [Clark, Fig. 4 and disclosure associated with Fig. 4];

receiving, at the virtual marketplace, a request for information regarding a requested commercial real estate service available from the service providers, wherein the request comprises request criteria identifying a specific property and at least one requested commercial real estate service for the specific property [Clark, Fig. 4 and disclosure associated with Fig. 4];

receiving service provider criteria from each of the service providers, the service provider criteria defining services provided by each respective service provider [Clark, Fig. 4 and disclosure associated with Fig. 4];

Clark does not specifically teach matching the request criteria with the service provider criteria of one of the service providers to identify a specific service provider that can provide the requested service. However, HomeGain teaches computer implemented system and method with the capability of matching the request criteria with

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the service provider criteria (member agents are notified every time there is work in their selected service location) [HomeGain, Page 26].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Clark with the idea of identifying services providers who can fulfill requested service to fulfill the customers procurement request.

Clark in view of HomeGain teaches capability for:

publishing the requested information at the virtual marketplace in response to receiving the request and based on the request criteria for the specific property, wherein the information is published as one of textual information regarding the commercial real estate service providers and links to web sites of the commercial real estate service providers (HomeGain teaches that Agents can provide link to their website in the Agent Profile) [HomeGain, page 25],

wherein the information published in said publishing step comprises information corresponding to the specific service provider identified in said matching step.

**Regarding claim 2,** Clark in view of HomeGain teaches capability to handle requests wherein the request criteria defines a request for a cost quote on the requested commercial real estate service, and wherein the information published in said publishing step comprises a cost estimate for the requested service based on criteria provided by at least one of the service providers (applicant is claiming a type of user requests at their claimed invention).

**Regarding claim 3**, as responded to earlier, Clark in view of HomeGain teaches capability to handle requests by

receiving service provider criteria from each of the service providers, the service provider criteria defining services provided by each respective service provider;

matching the request criteria with the service provider criteria of one of the service providers to identify a specific service provider that can provide the requested service,

wherein the information published in said publishing step comprises information corresponding to the specific service provider.

**Regarding claim 4**, Clark in view of HomeGain teaches capability to handle receiving payment via the virtual marketplace to conclude a transaction for the requested service [Clark, Fig. 4 and disclosure associated with Fig. 4].

**Regarding claim 11**, Clark in view of HomeGain teaches capability to handle requests wherein services comprise services and products (applicant is a claiming type of requests at their claimed invention).

**Regarding claim 13**, Clark in view of HomeGain teaches capability to handle requests wherein due diligence services comprise at least one of an engineering service, an environmental service, or an appraisal service (applicant is a claiming type of requests as their claimed invention).

**Regarding claim 14**, Clark in view of HomeGain teaches capability to handle requests wherein engineering service comprises at least one of a property condition report, an Americans with Disabilities Act compliance review, 'a building forensic study, construction monitoring, design/build construction, detailed design engineering, engineering desktop review, estimating, a feasibility study, a physical needs assessment, process engineering, reserve analysis, and a seismic study report (applicant is claiming a type of user requests at their claimed invention).

**Regarding claim 15**, Clark in view of HomeGain teaches capability to handle requests wherein environmental service comprises at least one of a Phase I, Phase II, or Phase III environmental assessment (applicant is claiming a type of user requests at their claimed invention).

**Regarding claim 16**, Clark in view of HomeGain teaches capability to handle requests wherein

Phase I environmental service comprises a protocol environmental assessment,

Phase II environmental service comprises at least one of asbestos assessment, lead-based paint assessment, underground storage tank management, a ground water survey, and an operation and maintenance program, and

Phase III environmental service comprises at least one of an asbestos screening, a lead-based paint screening, a transaction screening, governmental records searching and interpretation, and a report review and opinion.



(applicant is claiming a type of user requests at their claimed invention)

**Regarding claim 17,** Clark in view of HomeGain teaches capability to handle requests wherein wherein the appraisal service comprises at least one of a property valuation report, an ad valorem tax appraisal, a feasibility study, a financial reporting valuation, a highest and best use analysis, an impact analysis, insurance placement, and an insurance replacement cost study (applicant is a claiming type of user requests at their claimed invention).

**Regarding claim 18,** Clark in view of HomeGain teaches capability to handle requests wherein

request criteria defines a request for a cost quote on the requested commercial real estate service (applicant is a claiming type of user requests at their claimed invention), and

information published in said publishing step comprises a cost estimate for the requested service based on criteria provided by the specific service provider (applicant is claiming presenting contents specific about a service provider as their claimed invention).

**Regarding claim 19,** Clark in view of HomeGain teaches capability to handle requests wherein services comprise services and products (applicant is claiming a type of user requests at their claimed invention).

**Regarding claim 21,** Clark in view of HomeGain teaches capability to handle requests wherein request criteria identifying a specific property comprises at least one of a property address, a building size, a site size, an age of the building, a property type, and a number of buildings on site (applicant is claiming content of a search query as their claimed invention).

**Regarding claim 22,** Clark in view of HomeGain teaches capability to handle requests wherein requested commercial real estate service of the request criteria comprises at least one of an engineering service, an environmental service, or an appraisal service (applicant is claiming a type of user requests at their claimed invention).

**Regarding claim 23,** Clark in view of HomeGain teaches capability to handle requests wherein engineering service comprises at least one of a property condition report, an Americans with Disabilities Act compliance review, a building forensic study, construction monitoring, design/build construction, detailed design engineering, engineering desktop review, estimating, a feasibility study, a physical needs assessment, process engineering, reserve analysis, and a seismic study report (applicant is claiming type of user requests at their claimed invention).

**Regarding claim 24,** Clark in view of HomeGain teaches capability to handle requests wherein environmental service comprises at least one of:

a Phase I environmental service comprising a protocol environmental assessment,

Phase II environmental service comprising at least one of asbestos assessment, lead-based paint assessment, underground storage tank management, a ground water survey, and an operation and maintenance program,

Phase III environmental service comprising at least one of an asbestos screening, a lead-based paint screening, a transaction screening, governmental records searching and interpretation, and a report review and opinion.

(applicant is claiming a type of user requests at their claimed invention)

**Regarding claim 25,** Clark in view of HomeGain teaches capability to handle requests wherein appraisal service comprises at least one of a property valuation report, an ad valorem (according to the value) tax appraisal, a feasibility study, a financial reporting valuation, a highest and best use analysis, an impact analysis, insurance placement, and an insurance replacement cost study (applicant is claiming type of user requests at their claimed invention).

**Regarding claim 26,** Clark in view of HomeGain teaches capability to handle requests wherein request criteria defines a request for a cost quote on the requested commercial real estate service (applicant is claiming a type of user requests at their claimed invention), and

wherein the information published in said publishing step comprises a cost estimate for the requested service based on criteria provided by the specific service provider (applicant is claiming presenting contents specific about a service provider as their claimed invention).

### ***Conclusion***

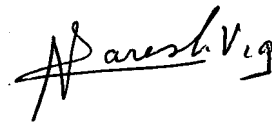
Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Naresh Vig". The signature is stylized with a large initial "N" and a long horizontal stroke.

Naresh Vig  
Examiner  
Art Unit 3629

August 27, 2007